

REMARKS

In response to the Final Office Action mailed April 28, 2009 ("Office Action"), no amendments have been made herein. Accordingly, claims 1-37 are pending.

Reconsideration and allowance of the present claims based on the following remarks are respectfully requested.

REJECTION UNDER 35 U.S.C. § 102

Claims 1-35 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Paten Application Publication No. 2006/0100094 to Boxhoorn et al. ("Boxhoorn"). Applicant traverses this rejection for at least the following reasons.

"A claims is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claims 1 and 20 recite, *inter alia*, that "... the functional layer has no catalytic function and forms a coating selected from the group consisting of anti-reflective, heat-resistant, and optical coatings." The cited portions of Boxhoorn do not teach these features.

For example, Applicant submits that the Office Action fails to show how the deposition layer of Boxhoorn allegedly does not have a catalytic function, as claims 1 and 20 recite. Indeed, none of the portions of Booxhorn which the Office refers to (*e.g.*, paragraphs 0007, 0011, 0014, 0041, 0053, and 0046, and Claims 1 and 14) teach that the functional layer does not have catalytic function. In fact, to the contrary, claim 1 of Booxhorn, recites "manufacturing *a catalyst layer* by depositing at least a second deposition material on the substrate by at least a second plasma cascade source, a plasma source, a vapor deposition

source and/or a sputtering sources." (emphasis added)¹; *see also* paragraph [0053] ("FIGS. 1 and 2 show an apparatus for manufacturing a catalyst.") (emphasis in original).

Moreover, the Office Action fails to show how Boxhoorn also teaches that the deposition layer "forms a coating selected from the group consisting of anti-reflective, heat-resistant, and optical coatings."

The Office Action, however, contends that "... films formed using plasma processing techniques produce films that are heat-resistant to some degree. However, the claim is not narrow enough to define the degree of how 'heat-resistant' the films are. In essence, a given film has some degree of heat-resistivity which the examiner cannot determine with no point of reference." Office Action, pg. 2. Applicant respectfully disagrees.

While Applicant recognizes that the degree a coating is "heat-resistant" may vary depending on a particular application of the functional layer, one of ordinary skill in the art would recognize the difference between films that are known in the field as being heat-resistant and those that are not. Moreover, the Office Action fails to identify any "heat-resistant" coating in Boxhoorn that is not a catalyst.

For *at least* the foregoing reasons, Applicant submits that a case of anticipation has not been shown and that independent claims 1 and 20 are patentable over Boxhoorn. Dependent claims 2-19 and 20-35 depend from independent claims 1 and 20, respectively and are therefore, patentable for the same reasons as claims 1 and 20 and for the further features they recite individually.

Accordingly, the rejection of claims 1-35 under 35 U.S.C. § 102(e) over Boxhoorn should be withdrawn and the claims be allowed.

¹ Claim 14 of Boxhoorn depends from claim 1.

REJECTION UNDER 35 U.S.C. § 103

I. Claim 36 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Boxhoorn and further in view of U.S. Patent Application Publication No. 2003/0193857 to Ichihara et al. ("Ichihara"); and

II. Claim 37 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Boxhoorn and further in view of U.S. Patent Application Publication No. 2004/0150326 to Shibata ("Shibata").

Applicant traverses each of these rejections. As pointed out by the Examiner, Boxhoorn qualifies as prior art under 35 U.S.C. § 102(e). Applicant respectfully submits that under 35 U.S.C. § 103(c), Boxhoorn cannot be used as prior art, because at the time the invention was made, the subject matter of the present claimed invention and Boxhoorn were commonly owned by OTB Group B.V. *See, e.g.,* 35 U.S.C. §103(c) and MPEP §2146.

In fact, the instant application is assigned to OTB Group, B.V. by way of assignment recorded at reel 018189, frame 0233; and Boxhoorn is assigned to OTB Group, B.V. by way of the assignment recorded at reel 017504, frame 0626. Copies of the Notices of Recordation for the present application and Boxhoorn are enclosed for the Examiner's information.

For *at least* the foregoing reasons, Applicant submits that the rejection of claim 37 and 38 under 35 U.S.C. § 103(a) based on Boxhoorn in view of either Ichihara or Shibata must be withdrawn and that the claims should be allowed.

CONCLUSION


Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

If an extension of time is necessary to prevent abandonment of this application, then such an extension of time is hereby petitioned for under 37 C.F.R. §1.136(a). Any fees required (including fees for net addition of claims) are hereby authorized to be charged to our **Deposit Account No. 033975** (Ref. No. 008895-0355438).

Date: **July 28, 2009**

Respectfully submitted,

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Patent Assignment Abstract of Title

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Total Assignments: 1

Patent #: NONE

Issue Dt:

Application #: 10583914

Filing Dt: 08/17/2006

Publication #: 20070190796

Pub Dt: 08/16/2007

Inventors: Martin Dinant Bijker, Franciscus Cornelius Dings, Marinus Franciscus J. Evers

Title: Method and apparatus for manufacturing a functional layer consisting of at least two components

Assignment: 1

Reel/Frame: 018189/0233

Recorded: 08/17/2006

Pages: 3

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

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Exec Dt: 07/21/2006

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Exec Dt: 07/17/2006

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Exec Dt: 07/17/2006

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Patent Assignment Abstract of Title

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Total Assignments: 1

Patent #: NONE

Issue Dt:

Application #: 10518695

Filing Dt: 09/20/2005

Publication #: 20060100094

Pub Dt: 05/11/2006

Inventors: Gosse Boxhoorn, Martin Dinant Bijker, Marinus Franciscus J. Evers et al

Title: Method and apparatus for manufacturing a catalyst

Assignment: 1

Reel/Frame: 017504/0626

Recorded: 09/20/2005

Pages: 5

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

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Exec Dt: 12/23/2004

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Exec Dt: 01/12/2005

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Exec Dt: 01/12/2005

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